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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,489	04/30/2001	David Bach	20816/2	2352

7590

08/26/2003

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EXAMINER

CHEU, CHANGHWA J

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 08/26/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,489

Applicant(s)

BACH ET AL.

Examiner

Jacob Cheu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16, 18-32, 34 and 38-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14, 16, 18-32, 34, 38-63 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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DETAILED ACTION

Applicant's amendments filed on June 13, 2003 has been received and entered on Paper No. 9.

The following information provided in the amendments affect the instant application.

- a. claims 5, 17, 33, 35-37 are cancelled.
- b. claims 1-14, 16, 18-23 and 34 are amended.
- c. claims 38-63 are newly added.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1, drawn to a reaction matrix, classified in class 385, subclass 12.
- II. Claims 2-6, 12-14, 16, 18-20, 26-32, 34, 41, 43, 45, 47, 53, 56, 58, drawn to a system for detecting the presence of target substances in samples, classified in class 436, subclass 518. *narrower*
- III. Claims 7-11, 21, drawn to a polymer nanotitre tray, classified in class 385, subclass 123.
- IV. Claims 22-25, drawn to a method for detecting the presence of target substance in samples, classified in class 435, subclass 7.32. *different*
- V. Claims 38-40, 42, 44, 46, 48-52, 54-55, 57, 59, 60-61, 62, 63, drawn to a system for detecting the presence of target substances, classified in class 422, subclass 82.08.

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1. The inventions are distinct, each from the other because of the following reasons:

Inventions (II, III, V) and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the features of a core region and a dielectric cladding region containing nanowells in invention I is not required for patentability of inventions II, III and V. The subcombination has separate utility such as conventional light sensitive etching where the nanowells serves as guiding for etching process.

2. Inventions II, III, and V are distinct and unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the feature of a polymer film waveguide core layer for propagating light, and a polymer waveguide cladding layer in contact with the core layer containing a plurality of nanowells in invention II, is not required by the claims of other groups. The feature of having a plurality of nanowells each situated internally in at least one of the cladding layers in invention III, is not required by the claims of other groups. The feature of having a plurality of fluorescent labels chemically attached to molecules in the test sample, and a means for causing said test

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samples with said chemically attached fluorescent labels to contact the bound molecules in the nanowells in invention V, is not required by the claims of other groups.

3. Inventions IV and (I, II, III and V) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus in inventions I, II, III and V can be practiced by a material different method other than invention IV, such as light scattering without fluorescence.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search for one group is not required for others, therefore restriction for examination purposes as indicated is proper.

5. Applicant is advised that reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Cheu whose telephone number is 703-306-4086. The examiner can normally be reached on 9:00-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 703-305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3399.

Jacob Cheu
Examiner
Art Unit 1641





LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

08/22/03